

Logo legalities

Dominic Green and Tom Wilkin explain the commercial importance of trade mark registration.



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TEN SECOND SUMMARY

- 1 Registration provides a statutory right to the trade mark and facilitates protection of it.
- 2 Unauthorised use of a trade mark may result in a claim for damages and destruction of offending goods.
- 3 Action can be taken for "passing off" if a trade mark is not registered, but this may be difficult.

Once a business has decided upon a trading or brand name, it is important to ensure that is appropriately protected because this has two benefits. First, the business has a statutory right to the exclusive use of the name and its associated goodwill. Second, if a third party is using a registered trade mark or a similar mark without permission, it is easier for a business to enforce its rights than if the mark is not registered.

Protecting a trading name

The most effective way for a business to protect its brand name is by registering it as a trade mark. In the UK, trade marks are registered with the Intellectual Property Office.

Trade marks are registered against different use classes, of which there are 45, representing different goods and services. For example, if a provider of legal services wished to register its trading name as a trade mark, it would likely seek protection under class 45, which covers legal and conveyancing services. The number of use classes a mark can be registered against is not limited, however the applicant cannot make an application to register a mark against classes for goods or services it does not, or does not intend to, provide.

Once registered, the proprietor will have exclusive rights to the use of the mark for ten years. And as long as the mark is still being used, registration can be renewed. The proprietor can give permission to another party to use the trade mark (usually by means of a license) or assign the rights to the trade mark in full.

Note that not all trading names can be registered, and an application will be refused if:

- The mark cannot be represented graphically.
- The mark is purely descriptive in nature.
- The trade mark would be contrary to public policy.

If an application is made to register a mark that conflicts with a pre-existing trade mark, the Intellectual Property Office may refuse registration and notify existing trade mark holders, providing them with an opportunity to object to the registration. In this circumstance, unless the parties can come to an agreement, the party making the application must either withdraw its application or the issue may have to be determined.

Use of a trade mark without permission

The proprietor of a trade mark has the right to bring an action for trade mark infringement. An infringement arises when a trade mark is used in the course of trade without the trade mark proprietor's permission. If the infringing mark is similar rather than identical to the registered mark, as long as it is being used for identical or similar goods or services and is likely to cause confusion to the public, the proprietor may be able to bring an action for trade mark infringement.

If such a claim is successful, the remedies available to a successful claimant may include injunctions, damages on account of profits, an order for the removal or destruction of offending signs and an order for delivery and destruction of offending goods.

Non-registered trading names

If a business does not register its trading name and finds a third party using it, the only available course of action is a claim for passing off. The claimant will need to show that there is goodwill attached to the goods or services provided under the name, that the act of the third party in using the name is likely to mislead the public as to the origin of its goods or services, and that the claimant has suffered damage. It is more difficult to successfully bring a claim for passing off and trade mark registration is desirable to effectively protect a trading name.